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REMARKS

The amendment of the specification corrects an obvious omission.

Claims 1, 3, 5-7 and 9-21 are pending herein. Claims 2, 4, 8 and 22-45 have been cancelled without prejudice or disclaimer.

The amendments to claim 1 are supported by original claim 4 (claim 4 is cancelled hereinabove) and in the specification at paragraphs [0024], [0025], [0030], [0036] and [0046]. No new matter is introduced.

Claim Rejection under 35 U.S.C. 102(E)—Steinke

Claims 1-3, 5-7, 9, 10 and 14-21 have been rejected under 35 U.S.C. 102(e) as being anticipated by U.S. 6,623,521 to Steinke et al. (Steinke). This rejection is respectfully traversed.

For a reference to anticipate a claim it must disclose each and every element of the claim. See MPEP 2131. See also *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989) and *In re Marshall*, 578 F.2d 301, 304, 198 U.S.P.Q. 344, 346 (CCPA 1978).

For anticipation a reference "must sufficiently describe the claimed invention to have placed the public in possession of it." *Paperless Accounting, Inc. v. Bay Area Rapid Transit System*, 804 F.2d 659, 231 U.S.P.Q. 649, 653 (Fed. Cir. 1986).

Steinke fails as an anticipation in light of the MPEP and legal precedent.

The concept of the present claims is the control of changes in rigidity of a medical device, e.g., a stent, so that the device becomes decreasingly rigid and increasingly biomechanically compatible with body tissues in contact with the device over a period of time. That concept can not be found in the Steinke reference. *Ex parte Rubin*, 5 U.S.P.Q. 2d, 1461 (BPAI 1987).

The concept of Steinke is a particular method of forming a stent from a plurality of flat sliding and locking elements. All of the claims and essentially the complete disclosure are drawn to the mechanical aspects of that concept.

The examiner has referred to columns 14-18 broadly with no explanation of what specific parts of that disclosure are considered to anticipate the present claims.

Steinke describes stents that are degradable. "Coatings" are disclosed in a single short paragraph at column 17, lines 31-37. There is no disclosure, however, of selection of that

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coating so that it will perform the function recited in the instant claims (i.e., controlling the rate at which the inner core material becomes flexible upon contact with bodily fluids). That element of the invention claimed and the concept embodied in that invention is not found in that paragraph or elsewhere in the reference. Thus there is no anticipation. See the cases cited above.

Reconsideration and withdrawal of the above rejection are therefore requested

Claim Rejection under 35 U.S.C. 103(a)—Steinke

Claims 11-13 have been rejected under 35 U.S.C. 103(a) as being obvious over the disclosure of Steinke. This rejection is respectfully traversed.

The examiner's conclusion of obviousness is based on the unsupported statement that "it is well known in the art" to produce stents from the types of materials recited in claims 11-13. Without evidence, that type of conclusion is insufficient support for a *prima facie* case of obviousness. The requirements for making out a *prima facie* case of obviousness are set forth in MPEP 706.02(j). The examiner has failed to meet those requirements. With respect to an explanation based on logic and sound scientific reasoning, see also *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (BPAI 1993).

The fundamental defects of the Steinke reference to support any rejection are pointed out above and need not be repeated here.

Reconsideration and withdrawal of the above rejection are respectfully requested.

CONCLUSION

Applicant submits all pending claims are in condition for allowance, early notification of which is earnestly solicited. Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is made that the Examiner telephone the Applicant's attorney at (703) 433-0510 in order that any outstanding issues be resolved.

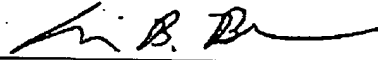
FEEES

If there are any fees due and owing in respect to this amendment, the Examiner is authorized to charge such fees to deposit account number 50-1047.

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Respectfully submitted,



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I hereby certify that this document and any document
referenced herein is being sent to the United States Patent
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David B. Bonham

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